

REMARKS/ARGUMENTS

Applicants have received and carefully reviewed the Office Action mailed December 28, 2009. Claims 21-35 are pending and have been rejected. Applicants respectfully traverse all adverse assertions and rejections presented in the Office Action. With this paper, claims 21 and 26 have been amended. No new matter has been added. Favorable consideration of the above amendments and the following remarks is respectfully requested.

Claim Rejections – 35 USC § 112

Claims 21-35 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Office Action states that it is not clear if a “connected proximal cage” is of specific definition or what the proximal cage may be connected to. Applicants respectfully traverse the rejection.

Claims 21-35 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Office Action states that there is insufficient antecedent basis in claims 21 and 26 for “the proximal cage”. Applicants respectfully traverse the rejection.

Without conceding the correctness of the rejections, Applicants have amended independent claim 21 and 26 in a way believed to obviate the 35 U.S.C. §112 rejections. Accordingly, Applicants respectfully request that the rejections be withdrawn.

Claim Rejections – 35 USC § 103

Claims 21, 22, and 24-31 were rejected under 35 U.S.C. §103(a) as being unpatentable over Engelson et al. (U.S. Patent No. 5,972,019), hereinafter Engelson, in view of Ginsburg (U.S. Patent No. 5,011,488). After careful review, Applicants must respectfully traverse this rejection.

Engelson, which has a filing date of June 5, 1997 and an issue and publication date of October 26, 1999 is available as prior art to the current application, which has a priority date of September 30, 1997, under 35 U.S.C. §102(e). However, 35 U.S.C. §103(c) applies in this instance to remove the reference as prior art against the current

application under 35 U.S.C. §103(a). See MPEP 2136.01. Both Engelson and the current application were subject to an obligation of assignment to the same person at the time the invention was made.

The Engelson assignment to Target Therapeutics, Inc. can be found at Reel 009069, Frame 0635. The assignment of the priority application, now U.S. Patent No. 6,066,149, to Target Therapeutics, Inc. can be found at Reel 009070, Frame 0910. Therefore, Engelson is disqualified as prior art in formulating the obviousness rejection under the provisions of 35 U.S.C. §103(c). Withdrawal of the rejection is respectfully requested.

Without the benefit of Engelson, Ginsburg is left to stand alone in making the rejection. Ginsburg does not appear to disclose all of the claim elements, as is required to establish a *prima facie* rejection. In particular, Ginsburg does not appear to teach a cage assembly including a proximal cage connected to a distal cage, wherein the proximal cage and the distal cage are separated by a separation member, as found in independent claims 21 and 26. Ginsburg, with or without the benefit of Engelson, does not appear to teach all the claim limitations, as is required to establish a *prima facie* rejection. Therefore, independent claims 21 and 26 are believed to be patentable over the cited references. Since claims 22, 24, 25, and 27-31 depend from claims 21 and 26 and add additional elements thereto, these claims are also believed to be patentable over the cited references. Applicants respectfully request that the rejection be withdrawn.

Claims 21-31 were rejected under 35 U.S.C. §103(a) as being unpatentable over Schmaltz et al. (U.S. Patent No. 5,449,372), hereinafter Schmaltz, in view of Ginsburg further in view of Crittenden et al. (U.S. Patent No. 4,719,924). After careful review, Applicants must respectfully traverse this rejection.

The Examiner has acknowledged that Schmaltz does not disclose “a cage assembly including a proximal and distal cage”. Ginsburg is said to teach proximal and distal elements. However, Schmaltz and Ginsburg, along or in combination, do not appear to disclose or suggest a proximal cage connected to a distal cage, wherein the proximal cage is separated from the distal cage by a separation member.

The Examiner has also asserted that “since Ginsburg teaches the use of two cages it is inherent that the proximal and distal cages would be able to be expanded by the same actuator element as shown.” First, it must be noted that Ginsburg does not appear to teach the use of two cages, but rather appears to teach two independently moveable funnel-shaped membranes, one of which is said to be a balloon and one of which appears to be a funnel shaped membrane. The two elements of Ginsburg do not appear to be operably coupled and so would not appear to share a common actuation element, particularly since they do not appear to share a common actuation mechanism. Second, “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).” (MPEP 2112, Part IV.) Ginsburg does not appear to describe a common actuator for both elements.

For at least the reasons discussed above, Schmaltz and Ginsburg, alone or in combination, do not appear to disclose or suggest a cage assembly including a proximal cage connected to a distal cage, wherein the proximal cage and the distal cage are separated by a separation member, as found in independent claims 21 and 26, nor do they appear to teach a actuator element for a cage assembly which includes both the proximal and distal cages. Accordingly, Schmaltz, Ginsburg, or a combination thereof does not appear to teach all the claim limitations, as is required to establish a *prima facie* rejection.

Crittenden et al. has been introduced as teaching “a core wire or guidewire with a coil tip at its distal end”, stating that “it would have been obvious to one skill in the art at the time the invention was made to use with the device of the combination of Schmaltz et al. and Ginsburg with a core wire or guidewire that is steerable instead of one that is not in view of Crittenden et al., so that the guide wire can be adjusted without requiring

removal of the guidewire when it is inserted into the patient.” Applicants note that the asserted teaching does not appear in the pending claims. Accordingly, the relevance of the Crittenden et al. reference is unclear.

Therefore, independent claims 21 and 26 are believed to be patentable over the cited references. Since claims 22, 24, 25, and 27-31 depend from claims 21 and 26 and add additional elements thereto, these claims are also believed to be patentable over the cited references. Applicants respectfully request that the rejection be withdrawn.

Claims 32-35 were rejected under 35 U.S.C. §103(a) as being unpatentable over Engelson et al. in view of Ginsburg and further in view of Lefebvre (U.S. Patent No. 5,421,832). After careful review, Applicants must respectfully traverse this rejection.

The Examiner states, on page 7, that the “combination of Engelson et al. and Ginsburg, as applied to claim 21, disclose the invention except for the cage including a plurality of petal shaped wires having a distal rake.” Applicants note that claims 34 and 35 depend from claim 26 and not from claim 21.

As discussed above, Engelson is not available as prior art in formulating the obviousness rejection under the provisions of 35 U.S.C. §103(c). Therefore, claims 21 and 26 are believed to be patentable over Engelson in view of Ginsburg. The single loops of the filter of Lefebvre do not appear to overcome the deficiencies of Engelson in view of Ginsburg as applied to independent claims 21 and 26. Therefore, claims 21 and 26 are believed to be patentable over the cited references. Since claims 32-35 depend from claims 21 and 26 and add additional elements thereto, these claims are also believed to be patentable over the cited references. Applicants respectfully request that the rejection be withdrawn.

Conclusion

In view of the foregoing, all pending claims are believed to be in condition for allowance. Further examination, reconsideration, and withdrawal of the rejections are respectfully requested. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,
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By their Attorney,

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